



NAGACO.215A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	: Staimer, et al.)	I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on <u>10/28/04</u> (Date) <u>R. M. Jelde</u> Russell M. Jelde, Reg. No. 54,198
Appl. No.	: 10/828,732)	
Filed	: April 21, 2004)	
For	: OPTICAL BIO-DISKS INCLUDING SPIRAL FLUIDIC CIRCUITS FOR PERFORMING ASSAYS)	
Examiner	: Unknown)	
Group Art Unit	: 1744)	

**PETITION TO FILE DECLARATIONS ON BEHALF OF NONSIGNING INVENTORS WHO
REFUSE TO SIGN OR CANNOT BE REACHED UNDER 37 CFR 1.47(A)**

Mail Stop Missing Parts
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notice to File Missing Parts mailed June 29, 2004, Applicants hereby petition under the provisions of 37 C.F.R. § 1.47(a), that the Commissioner accept for filing and examine the above-identified patent application despite the fact that one of the five joint inventors named in this application have not executed an oath or declaration. Applicants have been unable to secure declarations of inventorship from the nonsigning inventor despite diligent efforts and numerous requests on behalf of the inventors who have executed declarations. In support for this petition, Applicants provide the following:

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Filed : **April 21, 2004**

DECLARATION OF INVENTORSHIP

A Declaration of Inventorship, attached herewith, was executed by four of the five inventors, Norbert Staimer, Yihfar Chen, James Rodney Norton, and Jay Oliver C. Jison on behalf of themselves and on behalf of the omitted inventor Johnny Chen Mounphoxay, who has not signed the declaration of inventorship despite diligent efforts and numerous requests on behalf of the signing inventors. This partially executed Declaration satisfies the requirement that all available joint inventors must (i) execute an oath or declaration on their own behalf as required by 37 C.F.R. § 1.63 and (ii) execute an oath or declaration on behalf of the nonsigning joint inventor as required by 37 C.F.R. § 1.64, and in accordance with MPEP § 409.03(a) "an oath or declaration signed by all the available joint inventors with the signature block of the non-signing joint inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the non-signing inventor(s), unless otherwise indicated."

STATEMENTS OF FACTS

Applicant provides the following declaration, attached herewith, in support of its conclusion that nonsigning inventor refuses to sign and/or cannot be reached:

1. Declaration of Russell Jeide in Support of Petition To File Declaration On Behalf Of Nonsigning Inventor Who Refuses to Sign or Cannot Be Reached Under 37 CFR 1.47(a).

The Declaration shows the efforts of Applicants to contact the nonsigning inventor by email, telephone, and U.S. Mail to obtain his cooperation.

LAST KNOWN ADDRESS OF THE NONSIGNING INVENTORS

The last known address of Johnny Chen Mounphoxay is: 2251 W. Falmouth Avenue, Anaheim, CA 92801. Mr. Mounphoxay is a United States citizen.

CONCLUSION

Based on the foregoing, it is submitted that diligent efforts have been made to obtain a signature for the Declaration of Inventorship from Johnny Chen Mounphoxay. Despite these diligent efforts, Applicants have not been able to obtain a declaration from Mr. Mounphoxay. Applicants submit that the remaining joint inventors, Norbert Staimer, Yihfar Chen, James

Appl. No. : 10/828,732
Filed : April 21, 2004

Rodney Norton, and Jay Oliver C. Jison make the application for patent on behalf of themselves and on behalf of the omitted inventor Mr. Mounphoxay, in accordance with 37 C.F.R. § 1.47 (a). Furthermore, Applicants respectfully submit that the Declaration of Inventorship executed by four of the five named inventors satisfies the requirement that all available joint inventors (i) make oath or declaration on their own behalf as required by 37 C.F.R. § 1.63 and (ii) make oath or declaration on behalf of the nonsigning joint inventor(s) as required by 37 C.F.R. § 1.64.

Applicants respectfully request that this petition under 37 C.F.R. §1.47(a) be granted and that the Applicants be allowed to file and prosecute the above-identified patent application without the signature of Mr. Mounphoxay. If there are any obstacles to a prompt approval of this petition, the Patent and Trademark Office is invited to call the undersigned attorney.

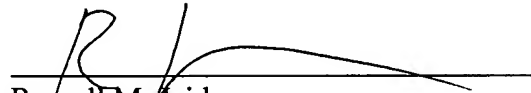
Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: _____

10/28/07

By: _____


Russell M. Jeide
Registration No. 54,198
Attorney of Record
Customer No. 20,995
(619) 235-8550

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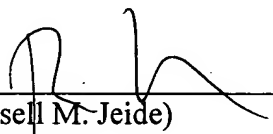
DECLARATION IN SUPPORT OF PETITION TO FILE DECLARATION ON BEHALF
OF NONSIGNING INVENTORS WHO REFUSE TO SIGN OR CANNOT BE REACHED
UNDER 37 CFR 1.47(A)

I, Russell M. Jeide, hereby declare that, to the best of my knowledge, information, and belief, the following is true, accurate, and correct:

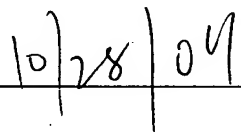
- 1) I am an associate attorney at Knobbe, Martens, Olson & Bear, LLP ("KMOB") and help coordinate prosecution of patent matters assigned to our client, Nagaoka and Co., LTD ("Nagaoka").
- 2) On November 4, 2003, Burstein Technologies, Inc. ("BTI") sold an undivided partial ownership interest in all intellectual property matters to Nagaoka. Prior to November 4, 2003, BTI terminated all employees.
- 3) On April 21, 2004, a patent application was filed on behalf of Nagaoka, titled "Optical Bio-Disks Including Spiral Fluidic Circuits for Performing Assays." This application claims priority to a provisional application that was subject to the November 4, 2003 assignment from BTI to Nagaoka. Accordingly, the listed inventors were previous employees of BTI.
- 4) This application was assigned Application Number 10/828,732 ("the '732 application") by the U.S. Patent and Trademark Office, and claims priority to U.S. provisional application number 60/464,869, filed on April 23, 2003.
- 5) On or about June 29, 2004, the U.S. Patent and Trademark Office mailed a Notice To File Missing Parts Of Nonprovisional Application, indicating that the filing fee and an Oath or Declaration were missing from the original application filing. The missing parts notice set a two month initial deadline for submitting the missing declaration and filing fee. Thus, the initial deadline for filing these documents was August 29, 2004.
- 6) After filing the application, I attempted to contact each of the inventors to secure their signatures on a declaration for the '732 application. I did receive executed declarations from four of the five listed inventors, Norbert Staimer, Yihfar Chen, James Rodney Norton, and Jay Oliver C. Jison. As outlined below, however, despite diligent efforts I was unable to secure an executed declaration from Johnny Chen Mounphoxay.
- 7) On or about April 19, 2004, I placed a telephone call to Mr. Mounphoxay in order to confirm his address information, notify him that the '732 application had been filed, and request his review of the application and execution of a declaration or inventorship. A child answered the phone and stated that his parents were not home. I left a message for Mr. Mounphoxay to call me back. I did not receive a return call from Mr. Mounphoxay.
- 8) On or about June 5, 2004, I left a message on an answering machine for Mr. Mounphoxay, asking him to return my call regarding his review of the '732 application and execution of a declaration of inventorship. I did not receive a response from Mr. Mounphoxay.
- 9) On or about June 5, 2004, I sent an email to Mr. Mounphoxay asking him to confirm his email address. The email was successfully delivered to an email account, as evidenced by the delivery receipt that is attached as Exhibit A. I did not receive a response from Mr. Mounphoxay.

- 10) On or about June 16, 2004, I prepared and sent a letter to Mr. Mounphoxay, including a copy of the '732 application and a corresponding declaration of inventorship for Mr. Mounphoxay's signature. The letter was sent via U.S. Certified Mail. Neither the return receipt nor the certified letter were returned. I received no response from Mr. Mounphoxay. A copy of the certified mail receipt and certified letter addressed to Mr. Mounphoxay is attached hereto as Exhibit B.
- 11) On or about September 27, 2004, I placed another telephone call to Mr. Mounphoxay but received a busy signal.
- 12) On or about September 27, 2004, I sent an email to Mr. Mounphoxay. Attached to that email was a copy of the '732 application and a declaration of inventorship for the '732 application. I indicated in the email that Mr. Mounphoxay's signature is needed on the declaration to complete the '732 application and that he should sign and date these documents and return them to me. I did not receive a response from Mr. Mounphoxay. A copy of the delivery receipt for this email is attached as Exhibit C.
- 13) On or about October 19, I received information from an in-house skip trace regarding Mr. Mounphoxay. The search did not include a street address or telephone number for Mr. Mounphoxay.

Signature:


(Russell M. Jeide)

Date:



Russell Jeide

From: mailer-daemon@kmob.com
Sent: Saturday, June 05, 2004 10:00 AM
To: rjeide@kmob.com
Subject: Delivery Notification - Message successfully relayed.



ATT22260.TXT (285ATT22261.TXT (987
B) B)

The following recipients have been successfully relayed.

<Jmounphoxay@yahoo.com>

"<KMOB.COM>" made the following annotations.

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Reporting-MTA: dns;kmob.com

Final-Recipient: rfc822;<jmounphoxay@yahoo.com>

Action: RELAYED

Status: 2.1.5 (250 recipient <jmounphoxay@yahoo.com> ok)

Remote-MTA: dns;64.157.4.78

ATT22261.TXT

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X-Server-Uid: 2B52B613-D83A-4286-AE7C-7FF80BABF2CF
Received: by EXCHANGE-OC with Internet Mail Service (5.5.2653.19) id <MG0XPCMF>; Sat, 5 Jun 2004 09:59:05 -0700
Message-ID: <906966CD08C9C04894808EED38D3B5B63AD9B7@EXCHANGE-SD>
From: "Russell Jeide" <rjeide@kmob.com>
To: "Johnny C. Mounphoxay (Jmounphoxay@yahoo.com)" <Jmounphoxay@yahoo.com>
cc: "Gisele Metcalf" <GMetcalf@kmob.com>
Subject: Burstein Technology patent application (NAGACO.215A)
Date: Sat, 5 Jun 2004 10:00:42 -0700
Return-Receipt-To: Russell Jeide <rjeide@kmob.com>
MIME-Version: 1.0
X-Mailer: Internet Mail Service (5.5.2653.19)
X-WSS-ID: 6CDF245D16040718-01-01
Content-Type: multipart/alternative;
boundary="-----=_NextPart_001_01C44B1E.A2CB48B0"
Content-Transfer-Encoding: 7bit

Russell M. Jeide
rjeide@kmob.com

June 16, 2004

Via Certified Mail – Return Receipt

Johnny C. Mounphoxay
2251 W. Falmouth Avenue
Anaheim, CA 92801

Re: U.S. Patent Application
Title: OPTICAL BIO-DISCS INCLUDING SPIRAL FLUIDIC CIRCUITS FOR
PERFORMING ASSAYS
Application No.: 10/828732 – Filed: April 21, 2004
Our Reference No.: NAGACO.215A

Dear Mr. Mounphoxay:

As you may now know, Nagaoka and Co., LTD (“Nagaoka”) is a partial owner of all intellectual property (including unfiled and pending patent applications, as well as issued patents) that were previously owned exclusively by Burstein Technologies, Inc. (“BTI”). As partial owner, Nagaoka is handling filing of new patent applications and maintaining pending applications. Our firm, Knobbe, Martens, Olson & Bear, LLP, has been retained by Nagaoka to handle these matters on their behalf.

You are listed as an inventor on a provisional application titled, “OPTICAL BIO-DISCS INCLUDING SPIRAL FLUIDIC CIRCUITS FOR PERFORMING ASSAYS,” which was filed in the U.S. Patent Office on April 23, 2003. In order to maintain a priority claim to this provisional application, we have filed a corresponding non-provisional application on April 21, 2004, which may be referenced using our docket no. NAGACO.215A.

In order to complete the filing of the above-listed application, we are required to submit certain formal documents to the U.S. Patent Office, each requiring your signature. These documents include (1) a declaration indicating that you are an inventor of the specific invention embodied in the specification and figures and (2) an assignment that transfers all rights in this application to BTI. Please note that, while notarization of the assignment is preferred, it is not required. If a notary is easily accessible, we will gladly reimburse you for their fee.

June 15, 2004

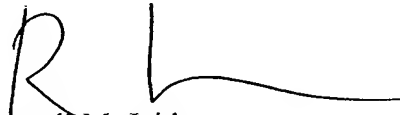
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Please also find attached an Oath & Assignment for filing in conjunction with an application that was filed in Taiwan, which also claims priority to the above-cited provisional application. This document does not require notarization.

Please review the attached declaration, assignment, and Oath & Assignment to ensure that they are accurate. You may then sign and date each document and return the originals to me via regular or express mail.

We appreciate your cooperation. Please contact me if you have any questions regarding this matter.

Best regards,



Russell M. Jeide

Enclosures

Certified Mail No.:
7003 2260 0003 1118 5212

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Postage	\$
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Return Receipt Fee (Endorsement Required)	
Restricted Delivery Fee (Endorsement Required)	
Total Postage & Fees	\$

Postmark
Here

Sent To
Street, Apt. No., or PO Box No.
City, State, ZIP+4

PS Form 3800, June 2002 See Reverse for Instructions

Russell Jeide

From: mailer-daemon@kmob.com
Sent: Monday, September 27, 2004 1:34 PM
To: rjeide@kmob.com
Subject: Delivery Notification - Message successfully relayed.



ATT256010.TXT
(289 B)



ATT256011.TXT
(993 B)

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<Jmounphoxay@yahoo.com>

"<KMOB.COM>" made the following annotations.

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Message-ID: <906966CD08C9C04894808EED38D3B5B687D2B8@EXCHANGE-SD>
From: "Russell Jeide" <rjeide@kmob.com>
To: "Johnny C. Mounphoxay (Jmounphoxay@yahoo.com)" <Jmounphoxay@yahoo.com>
cc: "Gisele Metcalf" <Gmetcalf@kmob.com>
Subject: FW: Burstein Technology patent application (NAGACO.215A)
Date: Mon, 27 Sep 2004 13:27:20 -0700
Return-Receipt-To: "Russell Jeide" <rjeide@kmob.com>
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X-Mailer: Internet Mail Service (5.5.2653.19)
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ATT256010.TXT

Reporting-MTA: dns;kmob.com

Final-Recipient: rfc822;<jmounphoxay@yahoo.com>

Action: RELAYED

Status: 2.1.5 (250 recipient <jmounphoxay@yahoo.com> ok)

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